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\*Admitted only in Maryland  
+Admitted only in Virginia  
♦Admitted only in Texas  
•Practice Limited to  
Federal Agencies

November 4, 2002

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Commissioner for Patents  
Washington, D.C. 20231

Art Unit 1642

Re: U.S. Utility Patent Application  
Appl. No. 09/720,086; 102(e): July 23, 2001  
For: *De Novo DNA Cytosine Methyltransferase Genes, Polypeptides and Uses Thereof*  
Inventors: Li *et al.*  
Our Ref: 0609.4560002/JAG/KRM

RECEIVED

NOV 05 2002

TECH CENTER 1600/2900

Sir:

Transmitted herewith for appropriate action are the following documents:

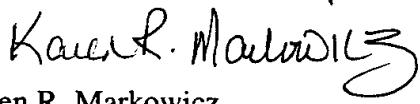
1. Reply to Restriction Requirement; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

  
Karen R. Markowicz  
Agent for Applicants  
Registration No. 36,351

KRM/DJN:drb  
Enclosures  
SKGF\_DC1:71294.1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Li *et al.*

Appl. No. 09/720,086

102(e): July 23, 2001

For: ***De Novo DNA Cytosine  
Methyltransferase Genes,  
Polypeptides and Uses Thereof***

Confirmation No. 6968

Art Unit: 1642

Examiner: Harris, A.M.

Atty. Docket: 0609.4560002/JAG/KRM

#10  
JW  
10/1/02

**Reply To Restriction Requirement**

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Commissioner for Patents  
Washington, D.C. 20231

NOV 05 2002

TECH CENTER 1600/2900

Sir:

In reply to the Office Action dated **October 2, 2002**, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-10 and 13. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter should this requirement be made final. In such case, Applicants retain the right to petition from this Restriction Requirement under 37 C.F.R. § 1.144.

This election is made with traverse.

As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents

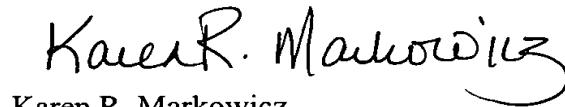
and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made. Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required<sup>1</sup>, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,  
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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<sup>1</sup>Applicants note that the initial deadline for response is November 2, 2002, a Saturday. Thus, Applicants filing on November 4, 2002 is timely.